

REMARKS

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

Considering the matters as set forth in the Office Action, we have sent revised Declarations to the client, and request that this requirement be deferred.

Regarding the 35 USC 112 rejection, claim 14 has been amended to depend from claim 12, in which the rear pocket is set forth.

Regarding the various prior art rejections, including claims 1, 11, 16, 21, 22, 25, 26 and 29, they all basically involve the combination of Yamamoto and the Walters patent. To bring out the significant shortcomings of this proposed combination of references, we are attaching as Exhibit A, as set forth below a print of Fig. 5 from the Walters patent with the frame of the Yamamoto patent super imposed.

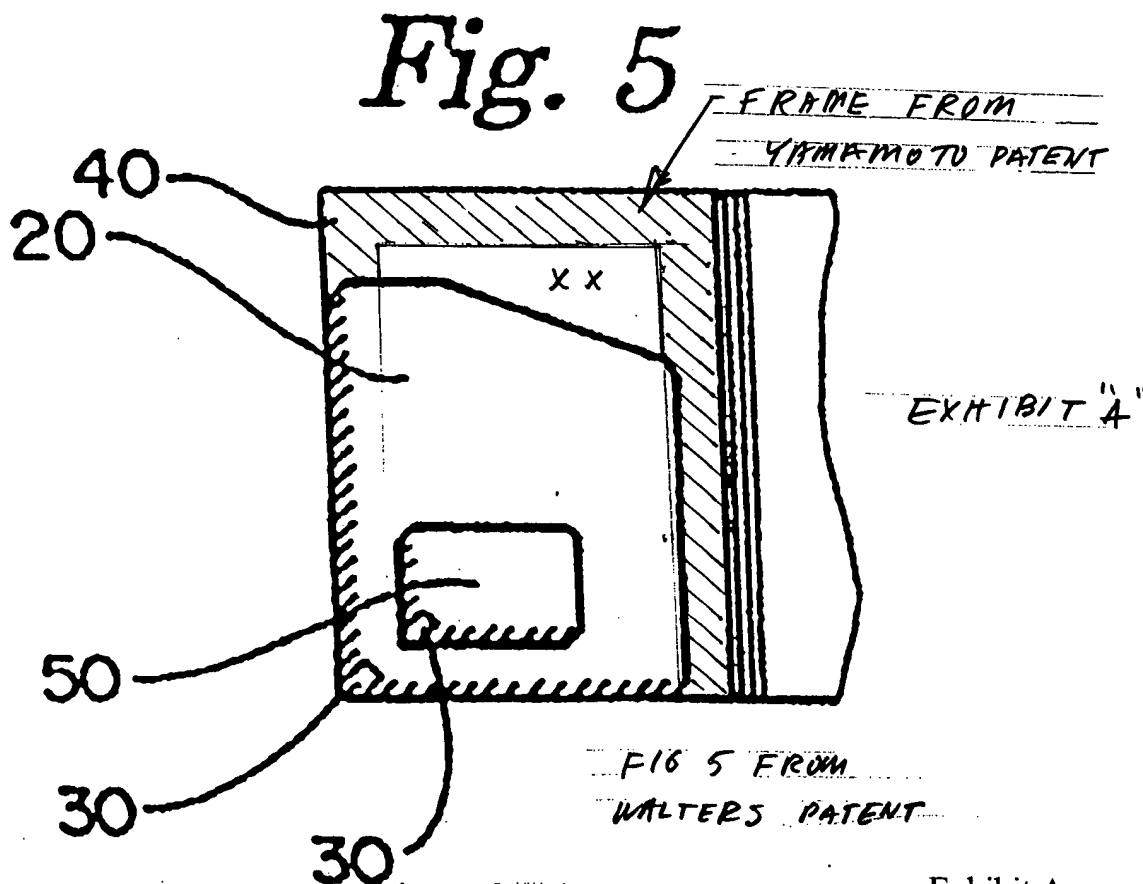


Exhibit A

Now, in Exhibit A, note the area XX where the inner pocket does not cover the area within the frame of the Yamamoto patent.

Accordingly, first, the inner pocket of the Walters patent is only intended to store extra papers, and Walters does not have a transparent cover, so there is no basis whatsoever for combining the two patents. However, as indicated in Exhibit "A", even if the two patents could be combined (even without teachings), they still would not anticipate the claims as amended. Thus, the area "xx" as marked in Exhibit A would be within the Yamamoto frame, but would not be supported by the pocket, as required by the limitation in the claims as amended: "said assembly including construction arrangements for holding said pocket firmly against said transparent cover over the entire open area of said frame".

Thus applicant's new construction requires not only an inner pocket but also a pocket which holds an insert firmly against the transparent cover over the entire open area of the frame.

In the present case, the inventors recognized the problem posed by the cover view patents such as Yamamoto 6,206,602 (cited in the introduction of the present application) in that it was difficult to insert visual inserts into the three sided pocket of Yamamoto type pockets. Further, the present inventors went on to devise a pocket construction secured along two sides, and located on the inside of the transparent cover which solved the problem.

In addition, with the pocket being at least co-extensive with the open area of the frame on the transparent front cover, the visual insert is held positively in the proper location.

In the present case, applicants were the first to perceive a problem and to develop a solution to the problem, and this is a classical type of fact situation which gives rise to patentability, as developed by the U.S. Supreme Court in Eibel Process Co. v. Minnesota and Ontario Paper Co., 261 US 45 (1923).

As mentioned above, the cover of the Walters patent is opaque, and does not have a frame as required by the claims. The pocket is disclosed as being intended to receive

miscellaneous loose paper and material. Accordingly, even if the cover of Walters were to be transparent, all that would be visible would be a loose batch of miscellaneous papers, not even firmly held against the cover.

It is only through the teachings of applicant's specification that the claimed combination could be created; and this clearly constitutes improper "hindsight" which has been widely condemned by the courts.

Here, we have the often-encountered "hindsight" pitfall at work, with applicants' application providing the only guide to the combination.

With regard to the use of "hindsight", or the use of the applicant's teachings to combine prior art, the courts have universally condemned such specious combinations and have upheld the validity of patents or claims of patents in which such hindsight was employed to combine the references. Notable among the decisions relating to the subject matter is the decision of the Supreme Court of the United States in the case of Diamond Rubber Co. of New York v. Consolidated Rubber Tire Co., 220 U.S. 428, 31 S. Ct. 444 (1911). In this case the Supreme Court stated "Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius'. . . . Knowledge after the event is always easy, and problems once solved present no difficulties, indeed may be represented as never having had any . . ." Id. at 434-35, 31 S. Ct. at 447. The Supreme Court then went on to uphold the patent under consideration.

In a similar vein, the Court of Customs and Patent Appeals stated in the case of In re Kamm and Young, 172 U.S.P.Q. 298 (C.C.P.A. 1972), that the basic mandate inherent in 35 U.S.C. § 103 is that piecemeal reconstruction of prior art patents in the light of applicant's disclosure shall not be basis for holding of obviousness. Similarly, in the case of Ex Parte Lange, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947), the Court said, "It seems to us that the examiner is using appellant's disclosure for the suggestion of the combination since there is no suggestion in any of the patents for their combination in the manner claimed by applicant. The cases of Ex Parte Myerson, 72 U.S.P.Q. 49 (C.C.P.A. 1946),

and Ex Parte Gary, 76 U.S.P.Q. 224 (C.C.P.A. 1947), are to the same effect. Two other cases decided by the C.C.P.A. in which hindsight was condemned are In re Stephens, Wenzel, and Browne, 145 U.S.P.Q. 656 (C.C.P.A. 1965), and In re Leonor, 158 U.S.P.Q. 20 (C.C.P.A. 1968). In the Stephens case, the Court stated that "References may not be combined indiscriminately and with guidance from applicant's disclosure to show that claims are unpatentable." 145 U.S.P.Q. at 657. In the Leonor case, the court dismissed the examiner's rejection of the claims in suit as "hindsight reconstruction of prior art" and disapproved of the board's affirmance of that rejection on the basis that it "violates [the] intent and spirit of 35 U.S.C. § 103." 20 U.S.P.Q. at 20-21. In Leonor, the court said that the issue is "whether teachings of prior art would of themselves, and without benefit of applicant's disclosure, suggest [a process] which would make claimed invention obvious..." (emphasis court's). Id at 21.

The Court of Appeals for the Federal Circuit has been equally strong in its condemnation of "hindsight" or similar rejections. Thus, for example, in ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929 (Fed. Cir. 1984), the Federal Circuit reversed a holding of invalidity because there was no teaching to combine the references. Similarly, the Federal Circuit, in W.L. Gore Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), referenced the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher," and condemned this type of rejection or holding of unpatentability.

Finally, reference is made to the decision of McGinley vs. Franklin Sports, Inc., 60 USPQ 2d 1001 (2001), in which the Court of Appeals for the Federal Circuit required strong teachings for combining references, particularly where at least one of the references teaches away from the invention.

To summarize, there is no teaching at all to combine the view type binder of Yamamoto with the pocket of Walters, and even if these references were to be combined they lack both the spirit and the structure of the present invention.

It is further noted that the proposed combination of the Yamamoto and Walters patents is applied to all claims with various additional references being also applied

relative to some of the claims. However, where the basic Yamamoto/Walters combination is not proper, as applied to the claims as amended, the remaining claims are similarly allowable.

Newly presented claim 30 includes the limitation quoted above, and accordingly should be considered allowable, in view of the deficiencies of the Yamamoto/Walters rejection.

In the event that this patent application is not considered to be entirely in condition for allowance, it would be appreciated if the Examiner would grant a telephone interview. Applicant's attorney would prefer a personal interview with the Examiner, but is located in Los Angeles so that a personal interview is not practical. Accordingly, a comparable telephone interview would be appreciated if the application is not considered allowable.

In conclusion, an early Notice of Allowance is respectfully solicited.

Applicant hereby authorizes the Commissioner to charge any additional fees, which may be required, or credit any overpayment to Deposit Account No. 06-2425. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefore.
Thank you.

Respectfully submitted,

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